

**REMARKS/ARGUMENTS**

Upon entry of the present Response, claims 17-35 will have not been amended but are resubmitted for consideration by the Examiner. In view of the above, Applicant respectfully requests reconsideration of the outstanding rejections of all the claims pending in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

Initially, Applicant would like to express his appreciation to the Examiner for the detailed Official Action provided.

Applicant further notes with appreciation the Examiner's acknowledgment of Applicant's Information Disclosure Statements filed in the present application on November 8, 2005 and January 19, 2006 by the return of the initialed and signed PTO-1449 Forms, and for consideration of the documents cited in the Information Disclosure Statements.

Turning to the merits of the action, the Examiner has rejected claims 17-18, 21-22, 25-26, 28, 30 and 32-35 under 35 U.S.C. § 103(a) as being unpatentable over CHOI (U.S. Patent Publication No. 2002/0040397) in view of MATSUURA (U.S. Patent Publication No. 2001/0021945). The Examiner further rejected claims 19-20 and 23-24 under 35 U.S.C. § 103(a) as unpatentable over CHOI/MATSUURA in view of IDEHARA (U.S. Patent Publication No. 2002/0038372). The Examiner has also rejected claims 27, 29 and 31 under 35 U.S.C. § 103(a) as being unpatentable over CHOI and MATSUURA in view of DAY (U.S. Patent No. 6,052,784).

Applicant respectfully traverses the above rejection based on the pending claims 17-35 and will discuss the outstanding rejection with respect to these claims in the present application as will be set forth hereinbelow.

Applicant's claims 17-20, 27, 28 and 33 generally relate to a scanner apparatus which scans image data and includes an interface configured to be connected to a terminal apparatus via a network. The scanner apparatus includes a controller which includes a search packet receiver configured to receive, from the terminal apparatus, a search packet, the search packet being utilized to search for a scanner apparatus connectable to the terminal apparatus. The controller also includes a response transmitter configured to transmit, to the terminal apparatus, a response to the search packet. The controller additionally includes a receiver configured to receive, from the terminal apparatus, terminal information, the terminal information including an IP address of the terminal apparatus, after the response to search packet is transmitted to the terminal apparatus. The controller also includes a transmitter configured to transmit to the terminal apparatus the scanned image data, based on the IP address of the terminal apparatus included in the received terminal information. Claims 21-24, 29-30 and 34 recite related terminal apparatuses. Claim 25, 31-32 and 35 recite related systems. Claim 26 recites a related method.

Each of the Examiner's rejections applied against the pending claims is based on CHOI as the primary reference. However, Applicant notes that the CHOI reference is not available as a reference against the pending claims. The CHOI reference was published on April 4, 2002, and was filed in the U.S. Patent and Trademark Office on October 2, 2001. Thus, its availability as reference against any of the claims in the

present application is only under 35 U.S.C. § 102(e). In this regard, Applicant notes that the present application is based on and enjoys the effective filing date of JP 2001-026646 which was filed on February 2, 2001, which is before the 35 U.S.C. § 102(e) date of the CHOI reference relied on by the Examiner.

Thus, Applicant submits that the CHOI reference is an inappropriate basis for the rejection of any of the claims in the present application. 35 U.S.C. § 102(e) specifies "the invention was described in --- a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent". Applicant notes that 102(e) does not apply to an application filed in a foreign country before the invention by the Applicant, but requires an application filed in the United States before the invention by the Applicant. Accordingly, under 35 U.S.C. § 102(e) CHOI is only entitled to his U.S. filing date of October 2, 2001. Thus, the CHOI reference is an inappropriate basis for the rejection of any of the claims in the present application. In other words, CHOI was filed after the invention of the pending claims, not "before the invention by the applicant for patent", as required for CHOI to come within the terms of 35 U.S.C. § 102(e).

In support of the above Applicant is submitting, concurrently herewith a certified English language translation of the priority document JP 2001-26646 to perfect Applicant's claim to the effective filing date.

Therefore, it is respectfully submitted that the features recited in Applicant's claims 17-35 are not rendered unpatentable by CHOI cited by the Examiner, since CHOI is not available as a reference with respect to the present claims.

Nevertheless, and independently of the above, Applicant submits that CHOI relates to an IP based network system in which the service client SC sends, to the lookup server 22, a query for an access to the service server SS (step S306 of Fig.5). The lookup server 22, sends to the service client SC, the information (an IP address of the service server SS) that is stored in the lookup server 22 about the service server SS (step S308 of Fig.5). By using the IP address of the service server SS, the service client SC requests the service server SS for access (step 310 of Fig.5). The service server SS sends a response to the service client SC (step 312 of Fig.5).

However, CHOI does not disclose a scanner apparatus which has a search packet receiver configured to receive, from the terminal apparatus, a search packet, the search packet being utilized to search for a scanner apparatus connectable to the terminal apparatus.

CHOI also does not disclose a scanner apparatus which has a receiver configured to receive, from the terminal apparatus, terminal information, the terminal information including an IP address of the terminal apparatus, after the response to the search packet is transmitted to the terminal apparatus.

Further, CHOI does not disclose a scanner apparatus which transmits, to the terminal apparatus, the scanned image data, based on the IP address of the terminal apparatus included in the received terminal information. In this regard, the Examiner admitted in the outstanding Official Action mailed on March 20, 2006 that CHOI fails to disclose transmitting, to the terminal apparatus, the scanned image data, based on the IP address of the terminal apparatus.

On the other hand, the present invention recites a scanner apparatus which receives, from the terminal apparatus, a search packet, the search packet being utilized to search for a scanner apparatus connectable to the terminal apparatus. The present invention also recites a scanner apparatus which receives, from the terminal apparatus, terminal information, the terminal information including an IP address of the terminal apparatus, after the response to the search packet is transmitted to the terminal apparatus. Further, the present invention recites a scanner apparatus which transmits, to the terminal apparatus, the scanned image data, based on the IP address of the terminal apparatus included in the received terminal information.

Thus, the pending claims are clearly distinguished over CHOI.

Therefore, it is respectfully submitted that the features recited in Applicant's claims 17-35 are not disclosed in CHOI cited by the Examiner.

MATSUURA relates to a scanning device which receives, from a computer connected to a network, an IP address of the computer and a plurality of parameters for reading and encoding an image, and sends mail to the IP address of the computer with an attached file of read image.

However, MATSUURA does not disclose a scanner apparatus which has a search packet receiver configured to receive, from the terminal apparatus, a search packet, the search packet being utilized to search for a scanner apparatus connectable to the terminal apparatus.

MATSUURA also does not disclose a response transmitter that transmits, to the terminal apparatus, a response to the search packet, since MATSUURA does not disclose the search packet recited in the pending claims, as discussed above.

Thus, the pending claims are clearly distinguished over MATSUURA.

Therefore, it is respectfully submitted that the features recited in Applicant's claims 17-35 are not disclosed in MATSUURA cited by the Examiner.

Thus, the CHOI reference is an inappropriate basis for the rejection of any of the claims in the present application. Further, neither CHOI nor MATSUURA (nor, inherently, any combination of the two) teaches at least a scanner apparatus which has a search packet receiver configured to receive, from the terminal apparatus, a search packet, the search packet being utilized to search for a scanner apparatus connectable to the terminal apparatus. Thus, no proper combination of CHOI and MATSUURA can be adequate to render Applicant's claims unpatentable, even if CHOI were available as a reference against the claims of the present application.

Regarding the rejection of dependent claims 27, 29 and 31 under 35 U.S.C. §103(a) as being unpatentable over CHOI and MATSUURA in view of DAY, Applicant submits that these dependent claims 27, 29 and 31 are respectively dependent from allowable independent claims 17, 21 and 25, which are allowable for at least for each the reasons discussed above. Thus, these dependent claims are also allowable for at least the reasons discussed above. Further, all dependent claims set forth a further combination of elements neither taught nor disclosed by any of the applied references.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections, and an indication of the allowability of all the claims pending in the present application, in due course.

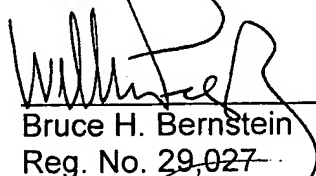
**SUMMARY AND CONCLUSION**

Applicant has made a sincere effort to place the present application in condition for allowance and believes that he has now done so. Applicant has re-submitted pending claims for re-consideration by the Examiner. Applicant has perfected his claim for priority and has thus eliminated the availability of the CHOI document as a reference against any of the claims pending in the present application.

With respect to the pending claims, Applicant has pointed out the features thereof and has contrasted the features of the claims with the disclosures of the applied references. Accordingly, Applicant has provided a clear evidentiary basis supporting the patentability of all claims in the present application and respectfully requests an indication of the allowability of all the claims pending in the present application in due course.

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,  
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